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BAKER BOTTS L.L.P. 2001 ROSS AVENUE, 6TH FLOOR DALLAS, TX 75201			EXAMINER JOSEPH, TONYA S	
			ART UNIT	PAPER NUMBER
			3628	
SHORTENED STATUTORY PERIOD OF RESPONSE		NOTIFICATION DATE	DELIVERY MODE	
3 MONTHS		01/05/2007	ELECTRONIC	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of this Office communication was sent electronically on the above-indicated "Notification Date" and has a shortened statutory period for reply of 3 MONTHS from 01/05/2007.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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## Office Action Summary

**Application No.**

10/601,342

**Applicant(s)**

SWEDBERG ET AL.

**Examiner**

Tonya Joseph

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06/20/2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 12/23/2003.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_.

**DETAILED ACTION**

***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-17 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

4. Claims 1-17 are rejected under 35 U.S.C. 101 because the claimed invention lacks patentable utility. The result of the instant invention is the implementation of initiatives and their added value being generated by a human being. The subjective judgment required to execute the steps would not always yield a substantially reproducible result. 35 U.S.C. 101 requires the claimed invention as a whole must be useful and accomplish a practical application. That is, it must produce a "useful, concrete and tangible result." In the instant case, the implementation of initiatives and their added value based on "brainstorming-like" idea generation can have varying results when subjected to the same data at different times and under varying circumstances. Due to the claims failure to provide a concrete or reproducible result, the statutory requirement under 35 U.S.C. 101 has not been met.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. The term "foster " in claim 10 is a relative term, which renders the claim indefinite. The term "foster " is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably appraised of the scope of the invention. It is unclear at what point the structure of the virtual community would be satisfactory in having fostered innovation. For Examination purposes, Examiner is interpreting foster innovation as the structure of a virtual community where innovation ideas are discussed.

### ***Claim Rejections - 35 USC § 102***

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1,8,10-13 and 15 are rejected under 35 U.S.C. 102(e) as being anticipated by Rowan et al. U.S. Pre-Grant Publication No. US 2003/0149610 A1.

7. As per Claim 1, Rowan teaches ***assessing an innovation status of an entity*** (see para. 34, lines 1-4); ***identifying at least one initiative with an innovation focus which is structured to increase the value of said entity*** (see para. 44, Examiner is interpreting defining strategic initiatives as identifying at least one initiative);

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**implementing said initiative** (see para. 83 lines 1-5); repeating said **assessing, identifying and implementing** (see para. 34 lines 9-10 and para. 38 lines 3-5).

8. As per Claim 8, Rowan teaches the method of claim 1 as described above.

Rowan further teaches **wherein said identifying includes building awareness of innovation within said entity** (see para. 50 lines 5-8, Examiner is interpreting focusing on core processes that encourage innovation as building awareness of innovation within said entity).

9. As per Claim 10, Rowan teaches the method of claim 8 as described above.

Rowan further teaches **wherein said building includes establishing a virtual community structured to foster innovation** (see para. 46 lines 2-8, Examiner is interpreting the second cross-functional team that defines strategic initiatives as a virtual community structured to foster innovation). By definition in Applicant's disclosure, a virtual community refers to a group of persons within the enterprise 11 and client 12 who are in a position to make positive contributions to the overall process (see para. 47).

10. As per Claim 11, Rowan teaches the method of claim 8 as described above.

Rowan further teaches **wherein said building includes feeding back information relating to said assessing, identifying and implementing** (see para. 44 lines 4-6).

11. As per Claim 12, Rowan teaches the method of claim 1 as described above.

Rowan further teaches **wherein said identifying includes generating ideas that represent potential said initiatives** (see para. 44 and para. 46 lines 1-2, Examiner is

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interpreting a cross-functional team defining strategic initiatives focused on the most profitable business segments as generating ideas that represent potential initiatives).

12. As per Claim 13, Rowan teaches the method of claim 12 as described above.

Rowan further teaches ***wherein said generating includes holding periodic workshops which each involve a plurality of persons and which are each structured to generate a plurality of said ideas*** (see para. 44 and para. 46 lines 1-2), Examiner is interpreting a cross-functional team defining strategic initiatives focused on the most profitable business segments as generating ideas that represent potential initiatives. A workshop being a seminar or discussion group that emphasizes exchange of ideas and the demonstration and application of techniques or skills exist in the method of Rowan due to the fact that the cross-functional team, which includes a plurality of persons, defines strategic initiatives.

13. As per Claim 15, Rowan teaches the method of claim 12 as described above.

Rowan further teaches ***wherein said identifying includes developing each of a plurality of said ideas into potential initiatives*** (see para. 44).

### ***Claim Rejections - 35 USC § 103***

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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15. Claims 2,4, 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rowan et al. in view of Sharmar International Publication No. WO 01/016836 A1.

16. As per Claim 2, Rowan teaches the method of claim 1 as described above.

Rowan does not explicitly teach **a further entity, and causing said entities to participate collaboratively in carrying out each of said assessing, identifying and implementing**. Sharmar teaches, at step 50, one or more coordinators are assigned to a entity. According to an embodiment of the invention, a coordinator may be in charge of engaging an entity and responsible for coordinating activities involved with the engagement. A coordinator may be a person within the entity (e.g. an employee), or may be from an outside party (e.g. a consultant) (see pg. 12 lines 29-31 ad pg. 13 lines 1-4). It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the method of Rowan to include a further entity with said entities participating collaboratively in carrying out each of said assessing, identifying and implementing in order to provide a medium to coordinate activities involved in the engagement, as taught in Sharmar pg. 13 lines 1-2.

17. As per Claim 4, Rowan teaches the method of claim 1 as described above.

Rowan does not explicitly teach **wherein said assessing includes having a plurality of persons each complete a survey which access a status of said entity with respect to each of a plurality of innovation-related factors**. Sharmar teaches, various personnel of an entity, including management personnel, may be interviewed to provide information. According to an embodiment of the invention, an initiative worksheet may be completed during the interview (see pg. 6 lines 24-30, Examiner is

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interpreting an interview of various personnel as a survey). Sharmar further teaches, Information may include sales and marketing information, relationship management information (e.g. organizational charts, annual reports, the competitive landscape for the entity, etc) (see pg. 6 lines 15-20, Examiner is interpreting all of the aforementioned types of information to be a plurality of innovation based factors. It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the method of Rowan to include having a plurality of persons each complete a survey which access a status of said entity with respect to each of a plurality of innovation-related factors in order to generate further information relating to strategy and goals for the identity, as taught in Sharmar pg. 7 lines 3-4.

18. As per Claim 5, Rowan teaches the method of claim 1 as described above.

Rowan does not explicitly teach, ***said accessing includes evaluating current performance of said entity with respect to each of a plurality of selected factors.***

Sharmar teaches, as described above with respect to Fig. 1, an entity may perform information audits regarding various aspects of the entity. Information audits may be performed within the entity's areas of interaction including information audits of the entity itself, the core information, product and service offerings of the entity, the entity's internal and external customers, and the entity's competitors. The areas of interaction may be both the current areas of interaction, and the entity's goals for areas of interaction (see pg. 13 lines 5-22, Examiner is interpreting performing information audits as evaluating current performance). It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the method of Rowan to



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include evaluating current performance of said entity with respect to each of a plurality of selected factors in order to form a basis for identifying potential strategic initiatives, as taught in Sharmar pg. 13 lines 26-27.

19. As per Claim 6, Rowan teaches the method of claim 1 as described above.

Rowan does not explicitly teach ***wherein said accessing includes evaluating a level of maturity of said entity with respect to each of a plurality of digital economy factors***. Sharmar teaches, another aspect of the invention relates to a strength model for an entity to better understand economic forces that effect the entity. By way of example, for an entity investigation Internet initiatives may use a strength model to determine the impact of the initiatives on digital value proposition, operating earnings, and market value (see pg. 15 lines 13-29). It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the method of Rowan to include evaluating a level of maturity of said entity with respect to each of a plurality of digital economy factors in order to determine the impact of the initiatives on digital competitiveness, as taught in Sharmar pg. 15 lines 14-16.

20. As per Claim 7, Rowan teaches the method of claim 1 as described above.

Rowan does not explicitly teach, ***evaluating said entity with respect to each of a plurality of selected factors***. Sharmar teaches, as described above with respect to Fig. 1, an entity may perform information audits regarding various aspects of the entity. Information audits may be performed within the entity's areas of interaction including information audits of the entity itself, the core information, product and service offerings of the entity, the entity's internal and external customers, and the entity's competitors.

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An information audit regarding customers may include issues about the definition of customers, segmentation, management, and growth (see pg. 13 lines 5-22, Examiner is interpreting an information audit regarding customers as evaluating said entity with respect to each of a plurality of selected factors). It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the method of Rowan to include evaluating said entity with respect to each of a plurality of selected factors in order to form a basis for identifying potential strategic initiatives, as taught in Sharmar pg. 13 lines 26-27; Sharmar further teaches **establishing an improvement goal for each of a plurality of said factors** (see p. 13 lines 27-30, Examiner is interpreting potential initiatives that are identified based on the information discovered via the audit and implemented by continuing the process as factors that have an established improvement goal).

21. Claims 3 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rowan et al. in view of Melis, European Patent Application EP 1 215 598 A1.

22. As per Claim 3, Rowan teaches the method of claim 1 as described above. Rowan further teaches, **developing a set of initiatives** (see para. 44, Examiner is interpreting defining strategic initiatives as developing a set of initiatives); **evaluating costs and benefits of each of said initiative in said set** (see para. 43 lines 1-5 and para. 44 lines 1-3, Examiner is interpreting plotting the revenue pool and establishing the industry trends as evaluating the costs and benefits of each said initiative).

Although, Applicant's evaluating occurs subsequent to the development of initiatives, the inventive concept of evaluating the costs and benefits of initiatives is the same and

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the order in which the evaluation is performed has no bearing in the determination of anticipation by Rowan. Rowan does not explicitly teach ***allocating funding to a subset of said initiatives in said set***. Melis teaches, for those business initiatives, which are selected from the Audition step (A), an optimized business plan is caused in a subsequent Final Casting step (FC). In a next step, after an optimized plan has been casted, funding capital for the company to be set up is acquired (see para. 40 lines 1-3 and para. 41, Examiner is interpreting business initiatives selected from the Audition step as subsets of said initiatives in said set). It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the method of Rowan to include allocating funding to a subset of said initiatives in said set in order to allow venture capitalist to have qualified material from which to pick their most interested initiatives, as taught in Melis para. 16); and ***wherein said implementing is carried out for each said initiative in said subset***. Melis teaches, after a financier has been found and enough venture capital has been secured, in a Pre-Production phase (PP) an execution plan of the initiative is compiled. After the Pre-Production step, in a final phase (P) the initiator of the initiative, together with the intermediary and its partners, perform a number of parallel actions in order to produce a working (e-) business organization 30 (see para 42 lines 1-4 and para. 43 lines 1-4). It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the method of Rowan to include said implementing carried out for each said initiative in said subset in order to realize a working organization within a certain period of time and

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convert the most valuable businesses into companies, as taught in Melis para. 11 and 12).

23. As per Claim 16, Rowan teaches the method of claim 12 as described above.

Rowan teaches ***evaluating costs and benefits of each of said potential initiatives***.

(See para. 43 lines 1-5 and para. 44 lines 1-3, Examiner is interpreting plotting the revenue pool and establishing the industry trends as evaluating the costs and benefits of each said initiative). Although, Applicant's evaluating occurs subsequent to the development of initiatives, the inventive concept of evaluating the costs and benefits of initiatives is the same and the order in which the evaluation is performed has no bearing in the determination of anticipation by Rowan. Rowan does not explicitly teach ***allocating funding to at least one of said potential initiatives, said implementing being carried out for each said initiative which is funded***. Melis teaches, for those business initiatives, which are selected from the Audition step (A), an optimized business plan is caused in a subsequent Final Casting step (FC). In a next step, after an optimized plan has been casted, funding capital for the company to be set up is acquired (see para. 40 lines 1-3 and para. 41). It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the method of Rowan to include allocating funding to a subset of said initiatives in said set in order to allow venture capitalist to have qualified material from which to pick their most interested initiatives, as taught in Melis para. 16). Melis further teaches, after a financier has been found and enough venture capital has been secured, in a Pre-Production phase (PP) an execution plan of the initiative is compiled. After the Pre-Production step, in a final

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phase (P) the initiator of the initiative, together with the intermediary and its partners, perform a number of parallel actions in order to produce a working (e-) business organization 30 (see para 42 lines 1-4 and para. 43 lines 1-4). It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the method of Rowan to include said implementing carried out for each said initiative in said subset in order to realize a working organization within a certain period of time and convert the most valuable businesses into companies, as taught in Melis para. 11 and 12

24. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rowan in view of Neal (Reference U of the attached PTO-892).

25. As per Claim 9, Rowan teaches the method of claim 8 as described above. Rowan does not explicitly teach ***wherein said building includes offering periodic presentations, which relate to recent developments in digital technology.*** Neal teaches, Organizations will take more interest in filling the knowledge gap as a means to increase productivity and reduce cost. This means less focus on technology for technology's sake and a greater emphasis on training workers, customers and partners. Irrational exuberance will be replaced with a greater level of sophistication in how success is measured; more attention will be paid to workers' ability to perform. Watch for e-enhanced informal learning using e-mail, threaded discussions, instant messaging, e-meetings, team rooms, and virtual workspaces. It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the method of Rowan to include offering periodic presentations, which relate to recent developments in

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digital technology to refocus corporate educators on the bottom line and achieving results, as taught in Neal para. 10 lines 1-2.

26. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rowan et al. in view of Vogt et al; U.S. PG Publication 2003/0028595 A1.

27. As per Claim 14, Rowan teaches the method of claim 12 as described above.

Rowan does not explicitly teach ***wherein said generating includes establishing a virtual site which continuously provides information about selected issues and can accept input representing said ideas.*** Vogt teaches the present invention provides a browser-enabled system of software and services that focuses on connecting people across spatial, temporal, and organizational barriers to achieve specific objectives. The system connects individuals to colleagues who can help them make decisions, solve problems, and learn quickly by helping them form a community with specific performance goals. The invention provides a virtual space, tools, activities, and business processes that enable users to meet, dialogue, share documents and links, develop best practices, provide mutual aid, and develop a sense of group identity (see para. 14, Examiner is interpreting tools and activities as selected issues and help making decisions as input ideas). It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the method of Rowan to include establishing a virtual site which continuously provides information about selected issues and can accept input representing said ideas in order to provide a meeting place for a learning community and a structure through which that community can achieve its goals, as taught in the Abstract of Vogt.

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28. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rowan et al. in view of Vogt et al in further view of Official Notice.

29. As per Claim 17, Rowan in view of Vogt teaches the method of claim 16 as described above. Rowan on view of Vogt does not explicitly teach holding periodic meetings to review and refine said implementing of each said funded initiative. Official Notice is taken that having periodic meetings to review and refine funded initiatives is old and well known in the art of strategic planning. It would have been prima facie obvious to one of ordinary skill in the art at the time of invention to modify the method of Rowan to include holding periodic meetings to review and refine said implementing of each said funded initiative in order to analyze the progress of the implemented initiative and alter any areas that are not in line with goals.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tonya Joseph whose telephone number is 571-270-1361. The examiner can normally be reached on Mon-Fri 7:30am-5:00pm First Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick J. Nolan can be reached on 571 272 0847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Tonya Joseph  
Examiner  
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